

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

Claims 2-6, 8, 9, 11-24 and 27 are pending in the present application. Claims 2, 12, 19, 20, 22 and 27 have been amended. Claims 1 and 10 have been cancelled, and claims 7, 25 and 26 were previously canceled, without prejudice or disclaimer of the subject matter contained therein. No new matter has been added by way of the above amendments.

Claims 2, 12 and 27 have been amended by incorporating the subject matter of claim 10. With the cancellation of claim 1, the dependencies of claims 19, 20 and 22 are appropriately changed.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 102(b)

Claims 1-3, 12-14, 22-24 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by **Tateno '782** (U.S. Patent No. 5,013,782) (see paragraphs 1-2 of the Office Action). Applicants respectfully traverse.

Applicants respectfully refer the Examiner to independent claims 2, 12 and 27 as shown herein. Also, the subject matter of claim 10 is not at issue here. Thus, Tateno '782 fails to disclose all instantly claimed features (e.g., component (c)). In this regard, anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949 (Fed. Cir. 1990) (citing *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)), which is not the case here. Thus, this rejection has been overcome. Withdrawal of this rejection is respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 1-4, 10-15 and 19-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Sato et al. '362** (US 2004/000362) in view of **Lyon '668** (U.S. Patent No. 5,460,668) and **Tateno '782** (see paragraphs 3-4 of the Office Action).

Also, claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over **Sato et al. '362** in view of **Lyon '668**, **Tateno '782** and **Kishi et al. '275** (U.S. Patent No. 4,021,275) (see paragraphs 5 of the Office Action).

Applicants respectfully traverse, and reconsideration and withdrawal of both rejections are respectfully requested. As stated in paragraph 6 of the Office Action, Applicants' previous arguments are rendered moot in view of the new rejections.

The Present Invention and Its Advantages

The instantly claimed inventions are characterized by containing phosphate glass which works as a slag-forming agent. Also, the present invention is directed to 0.5 to 5% by mass of the phosphate glass.

With the present invention, there is unexpected improvement in the generation of clean gas. Such an advantage is achieved by incorporating the mentioned phosphate glass which works as a slag-forming agent.

The cited references fail to disclose such features and advantages of the present invention.

Distinctions Over the Combination of Sato *et al.* '362, Lyon '668 and Tateno '782

The Examiner refers Applicants to various parts of the primary reference of Sato *et al.* '362 to disclose certain features (see Office Action, page 3, first paragraph). However, Sato *et al.* '362 fails to disclose, for example, the phosphate glass as instantly claimed.

The first cited secondary reference of Lyon '668 shows in its column 4, 2nd paragraph, that glass additive is used as a heat absorbing additive. Lyon '668 fails to show that the glass additive works as a slag former. Instead, Lyon '668 focuses on a powdered glass exhibiting a relatively high softening point (see, e.g., the paragraph bridging columns 2-3).

The second cited secondary reference of Tateno '782 shows adding phosphate glass to a flame-retardant resin in the smallest amount of 30%. Tateno '782 is a flame-retarding technique.

In the outstanding Office Action, the Examiner refers to the disclosure in Lyon '668 regarding the softening point being around 590 Celsius. The Examiner also refers to Tateno '782 to disclose that the softening point of phosphate glass ranges from 400-800 Celsius. In the Office Action, Lyon '668 is combined with Tateno '782 since Lyon '668 "teaches that it is known for use as a slag trap with gas generating compositions" and Tateno '782 suggests phosphate glass because of its disclosure of the softening point thereof (see Office Action at page 3, fourth paragraph). Also, the Examiner refers to how Sato *et al.* '362 discloses "conventional slag traps". However, the rationale for combining the three references is improper.

Applicants note that M.P.E.P. § 2143 set forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. Second, the Examiner has to provide some rationale for determining obviousness, wherein M.P.E.P. § 2143 set forth some such rationales that were set forth in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Regarding the rationales set forth in *KSR*, such a rationale should be made explicit. Also, the Examiner must interpret the reference as a whole and cannot pick and choose only those selective portions of the reference which support the Examiner's position. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.").

Such proper reasoning or rationale is not present in the Office Action. Tateno '782 simply does not teach or state to use phosphate glass in the Lyon '668 glass powder embodiment. The disclosure of the properties of a phosphate glass in Tateno '782 does not equate to using this glass in Lyon '668. It is clear that only a selective portion of, e.g., Tateno '782 is being used for the instant rejection (which is improper).

It is not even clear as to how Tateno '782 can even be properly cited. Tateno '782 is not even in an analogous art with Lyon '668 or the present invention, as this reference is directed to chlorine-containing resin compositions used to make, e.g., power cable coverings (see column 1, lines 5-25). Again, a cited reference must be considered in its entirety, and not selective parts thereof.

Furthermore, the Examiner states that Sato *et al.* '362 discloses "conventional slag traps" (referring to paragraph [0034] of the reference (see page 3, fourth paragraph of the Office Action). Yet, the primary reference fails to disclose the instantly claimed phosphate powder with the amount thereof.

Additionally, despite the citation of Lyon '668 and Tateno '782, the two secondary references are not even consistent with one another or with the present invention. For instance, Tateno '782 focuses on a flexible chlorine resin composition, whereas Lyon '668 is directed to completely different technology. As another instance, Tateno '782 requires a certain chlorine content (see, e.g., column 2, lines 49+; see also the claims) wherein neither the present invention nor Lyon '668 has such a requirement. Further, the flame-retarding technique of Tateno '782 is in contrast to the claimed invention wherein a composition will be combusted.

Thus, the rationale for combining Sato *et al.* '362, Lyon '668 and Tateno '782 is improper. *KSR Int'l, supra*. Further, combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art. *United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84 (1966); *see also* M.P.E.P. § 2143. Applicants note the unexpected advantages of the present invention, which includes the generation of cleaner gas. Also, Lyon '668 fails to even show its glass additive works as a slag former. Thus, this rejection has been overcome.

Finally, Applicants note the change to the claims shown herein. Component (c) has been redefined. Reconsideration is respectfully requested in view of the claimed component (c).

Distinctions Over the Combination of Sato *et al.* '362, Lyon '668, Tateno '782 and Kishi *et al.* '275 (claim 27)

Applicants note the arguments above, wherein such arguments apply to this rejection as well. Further citing Kishi *et al.* '275 does not make the combination of Sato *et al.* '362, Lyon '668 and Tateno '782 any more proper. This rejection is improper for the reasons above and thus has also been overcome.

Thus, the instant rejections are improper. Reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: May 30, 2008

Respectfully submitted,

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